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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,187	02/05/2004	Joe A. Wright	4688 (OSI0054/US/8)	7196
7590 David G. Burleson OMNOVA Solutions Inc. 175 Ghent Road Fairlawn, OH 44333-3300		04/18/2007	EXAMINER CHEN, VIVIAN	
			ART UNIT 1773	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/774,187

Applicant(s)

WRIGHT ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213:

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-11 and 14-22 is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/5/2007 has been entered.

### *Priority*

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/384,464, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Support for the newly added recitation of "wherein n

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is an integer from 1 to 5" in claim 1 is only present in Application Nos. 09/698,554 and 10/091,754. Applications No. 09/384,464 and earlier filed Applications only disclose n values ranging from 1 to 3.

Therefore, for the purposes of this Office Action:

Claims 1-7, 12-13 are deemed to have a filing date of 10/27/2000.

Claims 8-11, 14-22 are deemed to have an effective filing date of 03/05/1998.

***Terminal Disclaimer***

3. The terminal disclaimer filed on 4/5/2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of:

(a) U.S. Patent Nos. 6,660,828

has been reviewed and is accepted. The terminal disclaimer has been recorded.

4. The terminal disclaimers filed on 6/30/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of:

(a) U.S. Patent Nos. 6,686,051 and 6,383,651 and 6,423,418; and

(b) patents issuing from copending Application No. 10/966,528 (US 2005/0048213);

have been reviewed and is accepted. The terminal disclaimer has been recorded.

5. The double patenting rejections based on:

(a) U.S. Patent Nos. 6,686,051 and 6,383,651 and 6,423,418 and 6,660,828; and

(b) copending Application No. 10/966,528 (US 2005/0048213);

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have been withdrawn in view of the Terminal Disclaimers filed 6/30/2006 and 4/5/2007

***Claim Rejections - 35 USC § 102***

6. The rejections under 35 U.S.C. 102(b) of claims 14-22 based on:

(a) WEINERT ET AL (US 6,383,651); or

(b) CALLICOTT ET AL (US 6,423,418);

have been withdrawn in view of Applicant's amendments filed 4/5/2007 (establishing an effective filing date of 03/05/1998).

7. Claims 1-7, 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by:

WO 99/450079 (WO '079).

The above reference discloses curable or cured coatings derived from compositions comprising an amino resin (e.g., alkyl-etherified melamine formaldehyde resin) and a polymer comprising polyester segments and fluorinated polyether segments, wherein the polyether segments are derived from oxetane with pendant fluorinated groups linked to the polyether segments via an ether linkage, substrates coated with said coatings, and methods of forming such coated substrates, wherein the substrate is polyvinyl chloride, the coated substrates are dry erase materials and/or wall coverings, and wherein curing takes place at 150 F or more. (WO '079, see entire document).

***Claim Rejections - 35 USC § 103***

8. The rejections under 35 U.S.C. 103(a) of claims 14-22 based on:

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(a) WEINERT ET AL (US 6,383,651); or

(b) CALLICOTT ET AL (US 6,423,418);

have been withdrawn in view of Applicant's amendments filed 4/5/2007 (establishing an effective filing date of 03/05/1998).

9. Claims 1-7, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over: WO 99/450079 (WO '079).

Claims 1-7, 12-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO '079 as stated above. However, in the event the claims are not anticipated, the claims are obvious for the following reasons:

The above reference discloses curable or cured coatings derived from compositions comprising an amino resin (e.g., alkyl-etherified melamine formaldehyde resin) and a polymer comprising polyester segments and fluorinated polyether segments, wherein the polyether segments are derived from oxetane with pendant fluorinated groups linked to the polyether segments via an ether linkage, substrates coated with said coatings, and methods of forming such coated substrates, wherein the substrate is polyvinyl chloride, the coated substrates are dry erase materials and/or wall coverings, and wherein curing takes place at 150 F or more. (WO '079, see entire document)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the coatings disclosed in the above references to conventional substrates such as metals, plastics, polyvinyl chloride, etc. in order to form useful articles with stain resistant surfaces such as dry erase surfaces or wall coverings (claims 20-21). One of ordinary skill in

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the art would have adjusted the curing conditions of the coating (claim 22) depending on the specific curing characteristics of a given coating formulation and the thermal stability or resistance of the substrate to be coated.

*Response to Arguments*

10. Applicant's arguments filed 4/5/2007 have been fully considered but they are not persuasive.

(A) Applicant argues that claims 1-7, 12-13 are entitled to the priority date of 3/5/1998 because they are dependent on claim 8, which has an effective filing date of 3/5/1998. However, the effective priority date of a claim is dictated not solely by the effective priority date of the parent independent claim, but is determined individually for each and every claim; therefore, within a given claim, the presence of any claim language not fully supported by the priority documents affects the effective priority date of that specific claim. Because the relied upon priority documents Applications No. 09/384,464 and earlier filed Applications only disclose n values ranging from 1 to 3, the disclosure of those prior-filed applications (09/384,464 and earlier) fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Since the earliest support for newly added recitation of "wherein n is an integer from 1 to 5" in claim 1 is present in Application No. 09/698,554, claims 1-7, 12-13 are deemed to have an effective filing date of 10/27/2000, which is the filing date of Application No. 09/698,554.

*Allowable Subject Matter*

11. Claims 8-11, 14-22 are allowable over the prior art of record.

12. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to disclose or suggest a coated laminate, said coating comprising the recited resin comprising polyester segments and the recited polyether segments derived from oxetane monomers containing the recited pendent fluorinated group and ether linking group, in combination with the recited melamine resin, and the recited method of making said laminate. Specifically, MALIK ET AL references fails to specifically disclose the formation of the recited fluorinated polyoxetane-containing polyester resins; the WEINERT ET AL and CALLICOTT ET AL references fail to disclose the polyoxetane-polyester block copolymers in combination with melamine resins; copending Application 10/267,061 fails to claim the recited fluorinated oxetane-containing polyesters; TANAKA ET AL (US 5,681,890) and QUINN ET AL (US 4,714,657) fail to disclose the recited fluorinated oxetane-containing polyesters.



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*Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 13, 2007



Vivian Chen  
Primary Examiner  
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